

**REMARKS**

Confirming the provisional election made by Peter Cronk on 9/21/04, Group I claims, claims 1-19, and 38-41, are elected for prosecution and claims 20-29 and 30-37 are canceled without prejudice. Furthermore, claims 11 and 19 are also canceled without prejudice. Claims 1-10, 12-18, and 38-41 remain in this application for further prosecution on the merits.

Claims 1, 4, 7, 14, 17, 38, 39, 40, and 41 are amended.

**I. Objection to the Specification**

The Examiner objects to the title of the application because after the withdrawal of claims 20-37 there are no longer claims associated with a process of making an insulation product having antimicrobial/antifungal facing, or facing for same.

In response, the title of the application has been amended accordingly. Withdrawal of this objection is requested.

**II. Claim Rejections under 35 U.S.C. § 112**

The Examiner rejects claim 7 under 35 U.S.C. § 112, second paragraph, as being unpatentable for omitting the independent claim number upon which claim 7 is dependent. In response, claim 7 is amended to state that it depends from claim 1.

The Examiner further states that claim 7 employs improper Markush language. In response, claim 7 is further amended to now recite: "The building insulation of claim 1, wherein

said antifungal/antimicrobial agent comprises one or more of the following: . . . ." Thus, the amended claim 7 does not contain a Markush group.

The amended claim 7 now meets the requirement of 35 U.S.C. § 112, second paragraph. Withdrawal of the rejection is requested.

### **III. Claim Rejections under 35 U.S.C. § 103**

The Examiner rejects claims 1-4, 7-12, and 38-40 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,399,694 to McGrath et al. ("McGrath") in view of U.S. Patent No. 3,998,944 to Long et al. ("Long"). This rejection is traversed because McGrath and Long, either taken singly or in combination do not disclose the claimed invention and the Examiner has not shown a proper motivation to combine the McGrath and the Long references, as necessary to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

McGrath discloses a fiberglass insulation utilizing a PAG binder and incorporating a coloring agent adhered to the PAG binder to produce insulation batts in which the coloring agent is incorporated within the insulation batt. (McGrath in the Summary of the Invention; Column 2, lines 48-51; Column 4, lines 7-15). The invention of McGrath solves the problem of unsightly yellow color of resin-binderd fiber glass insulations in acoustical insulation application where the insulation batts are attached to a wall uncovered and exposed to help tune the sound of a room. (McGrath at Column 1, lines 26-37). McGrath discloses that a biocide may also be added in conjunction with the coloring agent. (Column 2, lines 15-18, lines 47-51). In reference to the use of the biocide, McGrath states:

Another, optional [] aspect of the invention is to include a biocide component in the batt. The biocide can be pumped into the known fiber-forming device for application to the batt moving along the conveyor, after the PAG binder is applied." (McGrath at Column 4, lines 45-49).

McGrath further discloses that the biocide may optionally be applied "in the field." (McGrath at Column 4, line 45 – Column 5, line2). This optional method of applying the biocide in the field is described in detail as spraying on to the insulation batt directly and not on the facing sheet. (McGrath at Column 4, line 56 – Column 5, line 2). McGrath states that when spraying the batt, "[c]are should be taken to not blind the batt, i.e., to not have the biocide be so viscous and so thickly applied that it fills the interstices of the batt" because that would damage the acoustic properties of the batt. The process of applying the biocide "in the field" disclosed in McGrath is, thus, limited to spraying an unfaced batt. Otherwise, one would not be concerned with blinding the batt. Accordingly, McGrath discloses a fiber glass insulation batt in which a biocide is provided adhered to the PAG binder in the fiber glass agglomeration or sprayed onto the unfaced batt in the field.

In contrast, however, amended claim 1 requires a building insulation comprising "a cellulosic facing, comprising at least one antifungal/antimicrobial agent present in an amount in weight of less than 200 ppm." Thus, McGrath does not disclose the invention claimed in amended claim 1 because the biocide in the insulation batt of McGrath is not in the facing. Furthermore, the Long reference cited by the Examiner does not correct this deficiency of McGrath because (1) Long and McGrath may not properly be combined under 35 U.S.C. § 103, and (2) even if the two reference could be properly combined, the combined teachings do not disclose the invention recited in the amended claim 1.

Long discloses a gypsum board whose paper facing contains a fungicide. As discussed above, McGrath discloses adding the biocide to the insulation batt in an acoustical insulation application where the insulation batt is attached to walls exposed. Thus, McGrath requires the applied biocide material to not blind the batt because to do so would damage the insulation's acoustic properties. In turn, it would be obvious to one of ordinary skill in the art that a faced insulation batts would not be used in such acoustical insulation applications. Hence, McGrath does not contemplate adding a biocide to the facing of a faced insulation batt. And indeed, McGrath does not disclose any motivation or suggestion to combine the teachings of the Long reference to add a biocide to the facing of a faced insulation batt.

The Examiner has not met the initial burden of establishing a *prima facie* case of obviousness. See MPEP §2143 ("[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings."); *see also In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper).

Additionally, even if the McGrath and the Long references could properly be combined, the combined disclosure still would not disclose the invention recited in the amended claim 1. The amended claim 1 requires that the facing include "at least one antifungal/antimicrobial agent present in an amount in weight of less than 200 ppm." Neither McGrath nor Long discloses that such low amount of antifungal/antimicrobial agent could be effective. McGrath does not specify an effective amount at all and the paper facing for a gypsum board that was effective in

inhibiting mildew growth was treated with a fungicide Cu-8-quinolinolate at the level of 0.066 %, which is 600ppm (Long at Column 6, line 3), substantially higher than the quantity required by claim 1. As disclosed in the originally filed Specification of the present application at paragraph [0028], the inventors were able to achieve the unexpected results of making fungal growth inhibiting paper facing by using substantially lower level of fungicide than the level recommended by the fungicide manufacturer. For example, as stated in paragraph [0028] of the specification, the label recommended dosage for RX-31 (new RX3100) fungicide of Hercules Inc., is 5.0 to 20.0 pounds per ton of dry fiber produced (i.e. the paper), which is about 2500-10000 ppm of the paper. The product label for RX-31 was submitted by the Applicant in an Information Disclosure Statement filed on April 16, 2004.

Accordingly, withdrawal of the rejection of claim 1 and its allowance are requested.

Claims 2-4, 7-10, and 12 depend from claim 1, which is allowable over the cited references. Thus, these claims are also allowable. Withdrawal of the rejection of claims 2-4, and 7-10 and their allowance are requested.

The Examiner rejects claims 5 and 6 as unpatentable under 35 U.S.C. § 103(a) as being obvious over McGrath in view of U.S. Patent No. 4,764,420 to Gluck *et al.* ("Gluck"). Gluck was cited by the Examiner as disclosing the limitations recited in the dependent claims 5 and 6. Namely, that the cellulosic facing is Kraft paper (claim 5) and that the facing has a basis weight of about 20-60 lbs. per 3000 ft<sup>2</sup>. However, as discussed above, amended claim 1, from which claims 5 and 6 depend from, is allowable over the McGrath reference. And the disclosure of

Gluck does not correct the deficiencies of the McGrath reference with respect to the invention recited in claim 1. Accordingly, claim 1 is allowable over the cited references, McGrath and Gluck and claims 5 and 6 are also allowable over the cited references McGrath and Gluck. Withdrawal of the rejection of claims 5 and 6 and their allowance are requested.

Claim 11 is canceled without prejudice. Therefore, the rejection of claim 11 is moot.

The Examiner rejects claim 13 under 35 U.S.C. § 103(a) as being obvious over McGrath in view of Long. Claim 13 depends from claim 1 which is allowable over McGrath and Long. Therefore, claim 13 is also allowable over the cited references. Withdrawal of the rejection and allowance of claim 13 are requested.

The Examiner rejects claims 14, 18 and 19 under 35 U.S.C. § 103(a) as being obvious over McGrath in view of Long. This rejection is traversed.

Claim 14 has been amended to recite:

A building insulation comprising a cellulosic facing, comprising at least one antifungal/antimicrobial agent added to the furnish pulp used to make said cellulosic facing in a quantity of less than 200 ppm based on the dry weight of the cellulosic facing, but high enough to render said facing mold resistant in accordance with ASTM C1338; and

an insulation layer adhered to said cellulosic facing by an adhesive, said insulation layer comprising randomly oriented inorganic fibers bonded together with a binder.

Thus, as in amended claim 1 discussed above, claim 14 also requires "a cellulosic facing, comprising at least one antifungal/antimicrobial agent . . . in a quantity of less than 200 ppm based on the dry weight of the cellulosic facing." As discussed above, in reference to the similar

limitations in claim 1, the Examiner has not shown a proper motivation to combine the references McGrath and Long. And for the same reasons as discussed in reference to claim 1, even if these references could be combined, the combined disclosure fails to disclose the invention recited in claim 14.

Accordingly, withdrawal of the rejection of claim 14 and its allowance are requested.

Claims 18 and 19 have been canceled without prejudice. Therefore, the rejection of claims 18 and 19 is moot.

The Examiner rejects claims 15-17 and 41 under 35 U.S.C. § 103(a) as being obvious over McGrath in view of Long and in further view of Gluck. This rejection is traversed.

Claims 15-17 depend from the independent claim 14. As discussed above in reference to claim 14, claim 14 is allowable over McGrath and Long for the same reasons discussed in reference to claim 1. And as discussed in reference to claims 5 and 6, because Gluck does not correct the deficiencies of McGrath and Long with respect to the inventions recited in claim 14, the disclosures of McGrath, Long and Gluck whether taken singly or in combination do not disclose the invention of claim 14. Accordingly, claims 15-17 are also allowable over the cited references McGrath, Long and Gluck.

Independent claims 38-40, as amended, each now recite "a cellulosic facing comprising at least one antifungal/antimicrobial agent present in an amount in weight of less than 200 ppm . . ." This is the same limitation found in the amended claim 1. Accordingly, for the same

reasons discussed above in reference to amended claim 1, amended claims 38-40 are also allowable over the cited references McGrath and Long. Withdrawal of the rejection of claims 38-40 and their allowance are requested.

**IV. Other Amendments**

Claim 4 is amended to better define scope of the invention claimed.

Claim 17 is amended to correct a typographical error.

In view of the above, Applicants believe that all objections and rejections have been overcome and the claims as amended are in condition for allowance. Reconsideration of the pending claims and an early Notice of Allowance are earnestly solicited.

Respectfully submitted,

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